

IV. Remarks

Applicants submit these amendments with a Request for Continued Examination in view of the Advisory Action mailed February 14, 2006, in which the Examiner stated that entry of the after final amendments filed January 30, 2006, would raise new issues that would require further consideration and/or search. Applicants previously filed an Amendment and Notice of Appeal on January 30, 2006, in response to a final Office Action dated July 28, 2005. Applicants respectfully request entry of these amendments and that the previously-filed amendments dated January 30, 2006, not be entered.

After entry of these amendments, claims 2-4 and 117 are pending.

Claims 5-17, 19-31, 33-40 and 104-106 have been cancelled without prejudice or disclaimer. Applicants retain the right to pursue the subject matter of these claims in future continuation or divisional applications.

In the Office Action Responses filed on April 11, 2005 and May 4, 2005, Applicants attempted to clarify the definition of $-(C(R_e)(R_f))_k-T-Q$ by redefining this term as $-(C(R_o)(R_p))_k-T-Q$ wherein the definitions of R_o and R_p were the same as that of R_e and R_f except that $(C(R_e)(R_f))_k-T-Q$ had been deleted from the definitions of R_o and R_p . With the current amendment, R_o and R_p have been deleted from the specification and claim 2, and the definition of $-(C(R_e)(R_f))_k-T-Q$, is instead editorially amended by the phrase, “ R_e and R_f are $-(C(R_e)(R_f))_k-T-Q$, wherein R_e and R_f are as defined herein.”

The proviso of claim 2 has been amended to state that the compounds of formula (I) must contain “at least three NO_2 groups linked through an oxygen atom, a nitrogen atom or a sulfur atom”, and is supported by the specification at, for example, page 47, line 31 to page 50, line 24; and page 52, line 6 to page 54, line 7 (i.e the elected species).

The specification and claims 3 and 117 have been amended to correct the typographical error for “latanoprost”. One would readily recognize the editorial error and that the Applicant intended to mean “latanoprost” and not “latanaprost.”

The specification and claims 3 and 117 have been amended to delete “beraprost, fluprostenol, limaprost, mistoprost and viprostol”.

No issues of new matter should arise and entry of the amendment is respectfully requested.

Rejection under 35 USC § 112, Second Paragraph

Claims 2 and 3 are rejected under 35 USC § 112, second paragraph, as being indefinite.

Claim 2 has been editorially amended for clarification. Applicants respectfully submit that the amendment would be obvious to one of ordinary skill in the art and is only being made to further clarify that the definition of R_e and R_f are all of the substituents that were defined previously and that these same substituents can be part of the $-(C(R_e)(R_f))_k$ -T-Q moiety.

Claim 3 has been amended to delete the names of the compounds that are not encompassed by the compounds of Formula (I).

In view of the thereof, Applicants respectfully submit that the claims satisfy the requirement under 35 USC § 112, second paragraph, and respectfully request that the rejection under this provision be withdrawn.

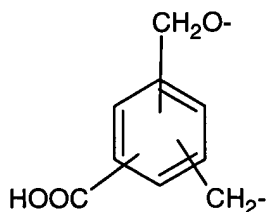
Rejection under 35 USC § 103(a)

Claim 2 is rejected under 35 U.S.C. § 103(a) as being obvious over Del Soldato (WO 98/58910).

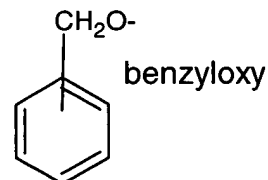
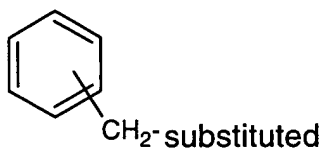
Applicants respectfully traverse the rejection and respectfully submit that the presently claimed invention is unobvious over the cited reference.

As stated in the Office Action response filed May 4, 2005, and reiterated herein, the compounds disclosed in Del Soldato are specifically excluded by the proviso in claim 2 of the present application. For example, Del Soldato's compound on page 8 of the Office Action (i.e. Example 1 on page 14 of WO 98/58910) is an alkyl mononitrate and is specifically excluded by the proviso for "an alkyl, branched alkyl or cycloalkyl mononitrate" at, for example, claim 2 and page 19, lines 4 and 5 of the present application.

Del Soldato's compound $-\text{CH}_2-(\text{COOH})\text{phenyl}-\text{CH}_2\text{O}$, on page 8 of the Office Action is specifically excluded by the proviso "benzoic acid substituted benzyloxy mononitrate" at, for example, claim 2 and page 19, line 10, of the present application. Del Soldato's compound, $-\text{CH}_2-(\text{COOH})\text{phenyl}-\text{CH}_2\text{O}$, is a benzoic acid substituted benzyloxy of Formula A:



The name of each substituent on the phenyl ring is described in more detail below:



Hence Del Soldato's compound $-\text{CH}_2-(\text{COOH})\text{phenyl}-\text{CH}_2\text{O}$ is specifically excluded by the present application.

As mentioned previously and stated by the previous Examiner in the Office Action dated November 25, 2004, the nitroprostaglandin compounds of Del Soldato are excluded by the proviso in claim 2 of the present application.

Additionally Applicants have amended claim 2 to include a proviso "wherein the compounds of Formula (I) must have at least one NO group or at least three NO₂ groups linked through an oxygen atom, a nitrogen atom or a sulfur atom". Applicants respectfully submit that Del Soldato does not disclose or suggest prostaglandin compounds that have at least one NO group or at least three NO₂ groups linked through an oxygen atom, a nitrogen atom or a sulfur atom. Based on the teachings in Del Soldato, there is no motivation to modify Del Soldato's nitroprostaglandin compounds to arrive at the compounds of Formula (I) of the present application that must have at least one NO group or at least three NO₂ groups linked through an oxygen atom, a nitrogen atom or a sulfur atom.

The compounds of the invention are not disclosed in Del Soldato, are structurally different from the compounds described in Del Soldato, and there is no motivation for one skilled in the art to make the claimed compounds based on the teachings in Del Soldato.

In view thereof, Applicants respectfully submit that the presently claimed invention is unobvious over the cited reference, and respectfully request that the rejection under 35 USC § 103 be withdrawn.

Objection

Claim 117 is objected to as containing non-elected subject matter.

Applicants respectfully submit that the names of the prostaglandin compounds listed in claim 117 are all encompassed by the compound of Formula (I).

In view thereof, Applicants respectfully request that the objection be withdrawn.

Rejoinder

Upon the finding of allowable subject matter, Applicants respectfully request the rejoinder and examination of composition claim 4. As stated on page 5 of the Petition decision dated July 13, 2005, "should the elected species (a compound) be found allowable, consideration of rejoinder of composition, method and kit claims must be considered".

Applicants respectfully submit that the Examiner is required to rejoin composition claim 4 upon the finding of allowable subject matter.

Conclusion

Applicants respectfully request reconsideration and allowance of claims 2-4 and 117.

Examiner Stockton is encouraged to contact the undersigned concerning any questions about the present application.

Respectfully submitted,



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